



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

SAITO, Makoto

Serial No. 08/416,037

Filed: March 31, 1995

For: METHOD FOR
CONTROLLING
DATABASE COPYRIGHTS

Examiner: H. SAYADIAN

Group Art Unit: 2202

RECEIVED

MAR 18 1997

GROUP 2200

PETITION TO CORRECT INVENTORSHIP UNDER 37 CFR 1.48(a)

Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Sirs:

Applicant hereby petitions the Commissioner to correct the inventorship of the above-identified application. The application was originally filed in the names of Shunichi Momiki and Makoto Saito as joint inventors. Shunichi Momiki was named in the application through error and without any deceptive intentions on the part of any of the two originally named inventors. Accordingly, applicant hereby petitions the Commissioner to remove Shunichi Momiki as a co-inventor so that the sole inventor in the above-identified application would be Makoto Saito. As explained below, all of the requirements of 37 CFR 1.48(a)(1) - (a)(4) are met in this petition.

Under 37 CFR 1.48(a)(1), Statements of Facts verified by the originally named inventors, Shunichi Momiki and Makoto Saito, are attached. These Statements of Facts establish when the error without deceptive intention was discovered and how it occurred.

Under 37 CFR 1.48(a)(2), a declaration by the actual inventor, namely Makoto Saito, is attached as required by 37 CFR 1.63 and 37 CFR 1.68.

Under 37 CFR 1.48 (a)(3), a fee of \$130.00 is enclosed as required under 37 CFR 1.17(h).

Under 37 CFR 1.48 (a)(4), a written Consent of the Assignee, the Mitsubishi Corporation, is attached.

All of the requirements of 37 CFR 1.48(a)(1) - (a)(4) having been met, applicant respectfully requests that this petition be granted and the application be amended to name Makoto Saito as the sole inventor.

Respectfully submitted,

HECKER & HARRIMAN

Date: 2/24/97

By: 

J. D. Harriman II
Reg. No. 31,967

JDH/maf
2029 Century Park East, Suite 1600
Los Angeles, California 90067
310-286-0377

CERTIFICATE OF MAILING

This is to certify that this correspondence is being deposited with the United States Postal Service as Express Mail Label No. EM100741464US in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231 on:

February 25, 1997


Mario Federis

02/28/97
Date



58800.919

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:)
SAITO, et al.)
Serial No.08/416,037)
Filed: March 31, 1995)
For: METHOD FOR CONTROLLING)
DATABASE COPYRIGHTS)

Examiner: Hrayr A. Sayadian

Group Art Unit: 2202

RECEIVED

MAR 1 8 1997

GROUP 2200

STATEMENT OF FACTS UNDER C.F.R. § 1.48(a)(1)

Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Sirs:

I, Shunichi Momiki, hereby declare that:

1. I have been, and currently am, an employee of the Mitsubishi Corporation. I was, and have been, the project leader of a project developed and implemented by Makoto Saito. However, I have made no contributions to the subject matter of any of the claims in the above-identified patent application.

2. I was originally named a co-inventor in the above-identified patent application because I believed that the Japanese patent laws require a project

leader to be listed as a co-inventor in a patent application applied for by a member of the project team. I also believed that the U.S. patent laws have the same requirements, namely that the project leader must be named as a co-inventor.

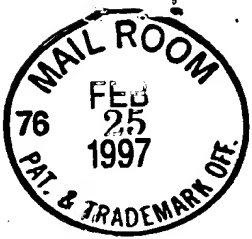
3. After receipt of the Examiner's Action in the above-identified patent application, I reviewed the present patent application with the legal department of the Mitsubishi Corporation. In the review, it was determined that the U.S. patent laws do not require a project leader to be named as a co-inventor. It was also determined that the naming of the project leader as the co-inventor was in fact improper under the U.S. law unless the project leader had in fact contributed to the subject matter of at least one claim.

4. As stated above, I have not contributed to the subject matter of any of the claims of the above-identified patent application. Thus, in the review of the patent application with the Mitsubishi legal department, it was determined that I should be removed as a co-inventor.

5. It is my understanding that at all pertinent times the invention and the patent rights thereto belong to the Mitsubishi Corporation. At no time did I stand to gain through the inadvertent addition of me as a co-inventor. This error occurred entirely through inadvertence.

I hereby declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that

Page 3



58800.919

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:)
)
SAITO, et al.)
)
Serial No.08/416,037)
)
Filed: March 31, 1995)
)
For: METHOD FOR CONTROLLING)
DATABASE COPYRIGHTS)

Examiner: Hrayr A. Sayadian

Group Art Unit: 2202

RECEIVED

MAR 18 1997

GROUP 2200

STATEMENT OF FACTS UNDER C.F.R. § 1.48(a)(1)

Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Sirs:

I, Makoto Saito, hereby declare that:

1. I have been developing and implementing a multimedia—software distribution project since 1991. During the project I have been, and currently am, an employee of the Mitsubishi Corporation, the assignee of the above—identified patent application.

2. During the development of the project, I, solely and without any contribution from any other person, invented the subject matter of all of the claims in the above-identified patent application.

3. During the development of the project, Shunichi Momiki has been, and currently is, an employee of the Mitsubishi Corporation. Shunichi Momiki was, and have been, the project leader of the project developed and implemented by me. However, Shunichi Momiki has made no contributions to the subject matter of any of the claims in the above-identified patent application.

4. Shunichi Momiki was originally named a co-inventor in the above-identified patent application because I believed that the Japanese patent laws require a project leader to be listed as a co-inventor in a patent application applied for by a member of the project team. I further believed that the U.S. patent laws have the same requirements, namely that the project leader must be named as a co-inventor.

5. After receipt of the Examiner's Action in the above-identified patent application, I reviewed the present patent application with the legal department of the Mitsubishi corporation. In the review, it was determined that the U.S. patent laws do not require a project leader to be named as a co-inventor. It was also determined that the naming of the project leader as the co-inventor was in fact improper under the U.S. law unless the project leader had in fact contributed to the subject matter of at least one claim.

6. As stated above, Shunichi Momiki has not contributed to the subject matter of any of the claims of the above-identified patent application. Thus, in the review of the patent application with the Mitsubishi legal department, it was determined that Shunichi Momiki should be removed as a co-inventor.

7. It is my understanding that at all pertinent times the invention and the patent rights thereto belong to the Mitsubishi Corporation. At no time did I stand to gain through the inadvertent addition of Shunichi Momiki as a co-inventor. This error occurred entirely through inadvertence.

I hereby declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the U.S. Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date: November 8, 1996

M Saito
Makoto Saito

CERTIFICATE OF MAILING
This is to certify that this correspondence is being deposited with the United States Postal Service as Express Mail Label No. TB1007A1A1AUS in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231 on:
Page 3 February 28, 1997
Makoto Saito 02/28/97
Signature Makoto Saito Date

DECLARATION AND POWER OF ATTORNEY FOR PATENT APPLICATION

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below, next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled

METHOD FOR CONTROLLING DATABASE COPYRIGHTS

the specification of which

XX Is attached hereto.
was filed on March 31, 1995 as
Application Serial No. 08/416,037
and was amended on _____
(if applicable)

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above. I do not know and do not believe that the same was ever known or used in the United States of America before my invention thereof, or patented or described in any printed publication in any country before my invention thereof or more than one year prior to this application, that the same was not in public use or on sale in the United States of America more than one year prior to this application, and that the invention has not been patented or made the subject of an inventor's certificate issued before the date of this application in any country foreign to the United States of America on an application filed by me or my legal representatives or assigns more than twelve months prior to this application.

I acknowledge the duty to disclose information which is material to the examination of this application in accordance with Title 37, Code of Federal Regulations, Section 1.56(a).

I hereby claim foreign priority benefits under Title 35, United States Code, Section 119, of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed:

<u>Prior Foreign Application(s)</u>			<u>Priority Claimed</u>	
<u>6-64889</u>	<u>Japan</u>	<u>1st, April, 1994</u>	<u>x</u>	
(Number)	(Country)	(Day/Month/Year Filed)	Yes	No
<u> </u>	<u> </u>	<u> </u>	<u> </u>	<u> </u>
(Number)	(Country)	(Day/Month/Year Filed)	Yes	No
<u> </u>	<u> </u>	<u> </u>	<u> </u>	<u> </u>
(Number)	(Country)	(Day/Month/Year Filed)	Yes	No

I hereby claim the benefit under Title 35, United States Code, Section 120 of any United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code, Section 112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations, Section 1.56(a) which occurred between the filing date of the prior application and the national or PCT international filing date of this application:

(Application Serial No.)	(Filing Date)	(Status -- patented, pending, abandoned)
(Application Serial No.)	(Filing Date)	(Status -- patented, pending, abandoned)

I hereby appoint HECKER & HARRIMAN, a firm including: Gary A. Hecker, Reg. No. 31,023; J. D. Harriman II, Reg. No. 31,967; and Christopher A. Mathews, Reg. No. 35,944 with offices located at 2029 Century Park East, Suite 1600, Los Angeles, California 90067, telephone (310) 286-0377, my attorneys with full power of substitution and revocation, to prosecute this application and to transact all business in the Patent and Trademark Office connected herewith.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Full Name of Joint Inventor Makoto SAITO

Inventor's Signature: *M Saito*

Date: November 8, 1996

Residence: Tokyo, Japan

Citizenship: Japan

(City, State, Zip) (Country)

Post Office Address: 2-12-6-104, Kaitori, Tama-shi, Tokyo, Japan

Full Name of Joint Inventor: Makoto SAITO

Inventor's Signature: _____

Date: _____

Residence: _____

Citizenship: _____

(City, State, Zip) (Country)

Post Office Address: _____